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**Request
for
Continued Examination (RCE)
Transmittal**

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	09/878,715
Filing Date	11 June 2001
First Named Inventor	McLoughlin, Stephen John
Art Unit	3672
Examiner Name	Giovanna M. Collins
Attorney Docket Number	01 PAT 140

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).
- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Rely Brief previously filed on _____
- ii. ☐ Other _____
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- iii. ☐ Information Disclosure Statement (IDS)
- ii. ☐ Affidavit(s)/Declaration(s)
- iv. ☐ Other _____

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other _____

3. **Fees**

- The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.
The Director is hereby authorized to charge the following fees, or credit any overpayments, to
- a. ☐ Deposit Account No. _____
- i. ☐ RCE fee required under 37 CFR 1.17(e)
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☐ Other _____
- b. ☒ Check in the amount of \$ 385 enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	C. W. Alworth	Registration No. (Attorney/Agent)	33.824
Signature		Date	25 May 2004

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Name (Print/Type)	C. W. Alworth	Date	25 May 2004
Signature			

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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Docket Number 01 PAT 140

25v04



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION

Applicants: McLoughlin et al.

Date: 25 May 2004

Serial No.: 09/878,715

Examiner: G. M. Collins

Filed: June 11, 2001 (U.S. National)

Group Art: 3672

For: A Wellbore Directional Steering Tool

RESPONSE TO FINAL OFFICE ACTION

and

REQUEST FOR CONTINUING EXAMINATION

To the Honorable Commissioner for Patents
Mail Stop – REC – Fee
P.O. Box 1450
Alexander, Virginia 22313-1450

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GROUP 3600

Dear Sir:

This is Applicants' second response to the subject application in reply to the Office Action mailed on 27 January 2004. A shortened statutory response period of three months was set by the Examiner making the response due on or before 27 April 2004. A petition accompanied by the correct fee for one month extension for a response by May 27, 2004 is enclosed.

The required fee (\$385 - small entity) for requesting a Continued Examination is enclosed and this request is believed to be properly set out as a response to a first office action. The required cover sheet accompanies this request as does a Certificate of Express Mailing dated 25 May 2004.

Summary of Important Points in the First Office Action

Restriction made Final

The Examiner acknowledged Applicant's election with traverse of Species I (claims 1-3, 4-9, 18-35, and 38-53). The Examiner did not find the traversal persuasive because the claimed methods and apparatus used to achieve the overall effect (move the drill bit in the desired direction) defined different inventions. Therefore, the restriction requirement was deemed proper and was made FINAL.

Drawings

The Examiner objected to drawings and in particular to Figures 1, 3, 5A and 5B, 6, 9, 10, 11 and 14. (It should be noted that all of the figures were submitted as informal drawings and technically none of the figures met the standards of the Office.)

In all cases the Examiner required a proposed drawing correction or corrected drawings in reply to the Office action to avoid abandonment of the application and stated that his objections to the drawings would not be held in abeyance.

Specification

The Examiner objected to the disclosure because of inconsistent terminology. The Examiner gave an example stating that, "throughout the specification the Applicant refers to cams, sleeves, eccentric sleeves, non-concentric sleeves, concentric sleeves, sleeves with an offset, sleeves without an offset, housings, eccentric housings, etc." The Examiner was unclear as to which of those terms were synonyms and to which of those terms designated a unique structure. The Examiner required that Applicant thoroughly edit the specification and ensure that the terminology is clearly and precisely defined and consistent.

Allowable Subject Matter

The Examiner stated that claim 21 would be allowable if rewritten to overcome the

rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action, and if it included all of the limitations of the base claim and any intervening claims.

Prior Art made of Record

The Examiner stated that prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art included U.S. Patent 4,697,650 to Fontenot, U.S. Patent 5,358,059 to Ho and U.S. Patent 3,626,482 to Quichaud.

Draftsperson's Review

Finally, there was the Draftsperson's Review was based on the informal revised drawings submitted with the original application. The Draftsperson essentially (and properly) rejected the drawings because of erasures/alterations, improper character of lines, and improper numbering and shading.

SUMMARY OF THE SECOND OFFICE ACTION

Specification

The Examiner accepted the corrections of the first amendment but objected to some continuing errors, namely:

On page 23 of the Amendments to the Specification line 5, the phrase “taken at 8A-8A in Figure 8” should be changed to - - taken at 9-9 in Figure 8 - -.

On page 14, line 4 of the original Specification the phrase “mandrel 4” should be changed to - - mandrel 11 - -.

The Examiner also had some objection to the language in claims 27, 28 and 30; however, the Examiner also continued to reject these claims under 35 U.S.C. § 102 (b) as previously disclosed by McLoughlin et al.

The Examiner required appropriate correction.

Drawings

The Examiner accepted the drawing revisions and additions but objected to revised Figure 9 because the original specification stated, “The thrust bearing, between the two elements, see location 28, on Figure 9.” The Examiner noted that Figure 9 has no element 28.

The Examiner objected to revised Figures 2 and 3 stating that the element labeled “11A” should be changed to - - 11B - -.

Finally the Examiner objected to the revised drawings in general because the drawings must show every feature of the invention specified in the claims. In particular the Examiner noted that the directional controller utilizing a single sleeve must be shown or those features must be cancelled from the claims.

Claims

The Examiner considered the arguments of the response to the first office action filed on September 2, 2003; however, the Examiner continued to reject claims 1, 3, 4, 9, 17- 20, 22-32,

34, 47, and 50-53 under 35 U.S.C. § 102(b) as being anticipated by McLoughlin et al. (US 5,979,570)

Allowable Subject Matter

The Examiner allowed that claims 5-8, 21 and 48-49 were objected to as being dependant upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Action Made Final

The Examiner made the second office action final.